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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,148	10/31/2003	Daniel Paul Karipides	T00105	1477
33438 7590 06/22/2010 HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720				
EXAMINER				
JEANTY, ROMAIN				
ART UNIT		PAPER NUMBER		
3624				
NOTIFICATION DATE		DELIVERY MODE		
06/22/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

Office Action Summary

Application No.

10/699,148

Applicant(s)

KARIPIDES, DANIEL PAUL

Examiner

Romain Jeanty

Art Unit

3624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-30 and 32-44 is/are rejected.
- 7) ☐ Claim(s) 13 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on February 10, 2010 has been entered.

Response to Arguments

2. Applicant's arguments filed February 10, 2010 have been fully considered but they are not persuasive.

Applicants asserted that Herz does not teach the present invention. Applicants further supported their assertion by arguing that Herz fails to teach a master session profile. The examiner respectfully disagrees. Herz teaches creating a profile of, developing and using profile of the user. Herz further discloses collecting the vector values of the textual attribute, for all target objects known to the system, and applying singular value decomposition to the resulting collection. Note col. 7, lines 9-43; col. 11, lines 34-46).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-13, 15-25 and 27-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 1, 14 and 26 are rejected under 35 U.S.C. 101 based on recent Supreme Court precedent and Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or apparatus, or (2) particularly transform a particular article to a different state or thing (also referred to as the "machine-or-transformation test"). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876); *In re Bilski*, 88 USPQ2d 1385 (Fed Cir. 2008). Also see USPTO Memoranda, "Guidance for Examining Process Claims in view of *In re Bilski*," January 7, 2009 and "New Interim Patent Subject Matter Eligibility Examination Instructions," August 24, 2009. Both memoranda may be located on the USPTO website at: <http://www.uspto.gov/web/patents/memoranda.htm>.

Additionally, there are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patentable. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or particular transformation

of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

If neither prong of the machine-or-transformation test is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101 and is non-statutory subject matter.

It is further noted that mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 USC 101, as seen in the Board of Patent Appeals Informative Opinion *Ex Parte Langemyr et al. (Appeal 2008-1495)*.

In the instant case, Applicant's method steps fail the first prong since they are not tied to a particular machine and can be performed without the use of a particular machine or apparatus. For example, the broadest reasonable interpretation of claims 1, 14 and 26 would be a method that could be performed by hand. Similarly, Applicant's method steps fail the second prong because they do not result in a transformation of a particular article to a different state or thing. Thus, claims 1, 14 and 26 are non-statutory.

Dependent claims 2-13, 15-25 and 27-28 merely add further details of the method steps recited in claim 1 without including any tie to a particular machine or apparatus or any transformation of a particular article to a different state or thing in a step that is more than insignificant extra-solution activity or mere field-of-use. Therefore, dependent claims 1, 14 and 26 are also non-statutory as they also fail both prongs of the machine-or-transformation test.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12, 14-30, 32-44 are rejected under 35 U.S.C. 103(a) as being anticipated by Herz et al (U.S. Patent No. 5,754,938).

Regarding claims 1, 5-7, 11-12, 14-17, 23-30, 32-34, and 41-44, Herz et al discloses a system and method for assisting customer service and identifying sales targets. In so doing, Herz et al discloses developing a set of master session profiles (col. 20, line 25-65), processing at least a subset of user session data to evaluate the user session data using the master session profiles (i.e., measuring the user session profile; col. 25, lines 10-65), determining product demand from the evaluation (col. 51 line 64 through col. 65 line 20).

Regarding claim 2, Herz further discloses wherein the product demand includes information regarding the demand of one or more features of a product (col. 20, line 25-65).

Regarding claim 3, Herz et al disclose wherein the product demand indicators include values of data types (col. 20, line 25-65).

Regarding claim 4, Herz further disclose a set of master session profiles

comprises developing a set of master session profiles from recorded data associated with users who either submitted a product lead or purchased a product (col. 11, lines 1-30).

Regarding claim 8, Herz et al further discloses wherein evaluating user session data using the master session profiles comprises matching at least a subset of the product demand indicators present in a user session with product demand indicators in the master session profiles (col. 7, lines 2-8).

Regarding claim 9, 20-23, 35-40, Herz et al further discloses assigning an indicator reflecting the product demand authenticity of each user session that is matched with the master session profiles col. 10, lines 49-54).

Regarding claim 10, Herz et al further discloses evaluations comprises associating product demand evaluations with specific products, weighting evaluations in accordance with a product demand authenticity indicator, and comparing the weighted evaluations of users sessions selecting a particular product against a total set of weighted evaluations of user sessions (col. 21, lines 21-32).

Regarding claim 11, Herz further discloses wherein the user session data includes data types associated with each users navigation of the network site during configuration of a product (col. 7, lines 9-60).

Regarding claim 12, Herz et al further disclose processing the user session data in accordance with a decision tree using data from the master session profiles as decision criteria (col. 26, line 41 through col. 27, line 40).

Claims 14-25 recite the same limitations of claim 1-12 above; therefore claims 14-25 are rejected under the same rationale relied upon of claims 14-25.

Claims 26-20 recite the same limitations of claim 1-12 above; therefore claims 14-25 are rejected under the same rationale relied upon of claims 14-25. In addition, Herz further discloses a second module for collecting a second set of user session and matching the second set of user session with a master profile set to determine product demand. Note col. 6, lines 32-58 of Herz.

Allowable Subject Matter

5. Claims 13 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJ/
June 7, 2010

/Romain Jeanty/
Primary Examiner, Art Unit 3624